

REMARKS

Applicant requests reconsideration and further examination of this application.

Applicant has filed an RCE with amendments and these remarks in response to the Office Action of April 15, 2005, made FINAL.

Applicant has canceled Claims 1-4 and 6-8, and has amended Claim 9 in response to the Office Action.

Claim 9 has been amended to recite that:

1. each display case in the system has its own, separate lid; and,
2. each lid fits within and rests upon the top of only the respective case (see Currently Amended Claim 9).

No new matter has been added because each case is shown with its own, separate lid in the drawings (except for Figures 6 and 7 which are detail views of the lower element connection to the front, rear and side elements, and in which Figures no lids are shown). Also, support for the lid dimensions feature is at paragraph #0021, fourth sentence, of the description.

Furthermore, it is clear from the drawings that the respective separate lids rest on the top edges only of the front, rear and side elements of each respective case (See Figures 1-5 , and 8-10). Therefore, no new matter has been added.

Respectfully, Applicant traverses the ϕ 103 rejection of the Office Action based on these amendments and remarks.

Respectfully, neither of the two (2) newly-claimed features of Applicant's invention are disclosed or suggested by the cited references.

The Grogan reference (U. S. Patent #6,325,281) discloses an insulated, corrugated cardboard shipping container with two inner layers of nested, open-top insulation housings. A single lid is provided which fits at once the tops of both insulation housings. The Grogan reference, then discloses only one lid for its entire nested assembly, while Applicant's claims require a separate lid for each nested display case. This is an important difference because in Applicant's invention each display case must have its own, separate lid in order to be operable as a display case.

The Gutsch reference (U.S. Patent #1,870,005) discloses a stackable clay model container with a base which supports the clay model, and a cover which slips over the upper part of the base in telescoping fashion. The limit of the telescoping movement of the cover over the base is provided by beads pressed into inner side walls of the cover. The Gutsch reference, then, discloses a different type of lid, compared to Applicant's claimed upper element. The Gutsch lid does not fit within nor rest upon the top edges of only the front, rear and side elements as claimed by Applicant. Also, in Gutsch, the base, not the cover, is the support for display of the clay model, whereas in Applicant's claims the lid supports the displayed item.

Respectfully, Applicant asserts that the above amendments make the amended claims allowable over the above - cited ϕ 103 references because:

- I. The cited references are non-analogous art, and are not properly citable against the amended claims;
- II. Even if properly citable against the amended claims (which they are not), the cited references are not properly combinable to be considered together against the amended claims; and,
- III. Even if properly combinable (which they are not), the combined teachings of the cited references still do not suggest the subject matter of the amended claims.

I.A. The Cited Grogan Reference is Non-Analogous Art

The Grogan reference is not in the same field of Applicant's invention. As discussed above, the Grogan reference does not relate to all to display cases. The disclosed Grogan device is only a shipping container - it has no disclosed display functionality. Applicant's invention, on the other hand, is a display case which also serves as a shipping container - relative to the Grogan reference, Applicant's invention has more functionality; it has dual display/shipping functionality.

Therefore, because, as discussed above, the Grogan reference is neither in the field of Applicant's invention, nor is it pertinent to the particular display case problem with which Applicant's invention is concerned, the Grogan reference is non-analogous art. Also, therefore, the Grogan reference may not be relied upon as a basis for a ϕ 103 rejection of Applicant's amended claims. In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). In Oetiker, Applicant's invention was an improved hose clamp. The claims were rejected under ϕ 103 based in part on a patent for a fastener for use in garments. The CAFC held that the garment fastener was non-analogous art and the reference was improperly cited.

I.B. The Cited Gutsch Reference is also Non-Analogous Art

Likewise, the cited Gutsch reference is also non-analogous art. As discussed above, the Gutsch reference does not relate at all to shipping containers. The disclosed Gutsch device is only for display and storage - it has no disclosed shipping functionality because the clay model is not secured to the base. Applicant's invention, on the other hand, is a display case which also serves as a storage and shipping container - relative to the Gutsch reference, Applicant's invention has more functionality; it has triple display/storage/shipping functionality.

Therefore, the Gutsch reference and Applicant's invention are not in the same field. The Gutsch reference and Applicant's invention are also not concerned with the same problem, either. Therefore again, Gutsch is non-analogous art, and may not be relied upon as a basis for a ϕ 103 rejection of Applicant's amended claims. In re Oetiker, supra.

II. The Cited References are not Properly Combinable

With the cited Grogan and Gutsch references, the Examiner has failed to establish a *prima facie* case of obviousness. This is because, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the references' teachings. Second, there must be a reasonable expectation of success from the modification or combination. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ 2d1438 (Fed. Cir. 1991), MPEP ϕ 2143.

In this case, there is clearly no teaching in Grogan or in Gutsch that they be combined to arrive at Applicant's newly claimed invention. Also, there is clearly no basis expressed in these two references of any reasonable expectation of success from modifying or combining their disclosures. This is because, as discussed above in Section I, not only are these two references non-analogous to Applicant's invention, they are also non-analogous to each other. In review, Grogan relates to shipping containers, and Gutsch, on the other hand, relates to storage and display containers, within which the stored item is not secured, and therefore, not operable for shipping. Therefore, these two references are not rationally related, and a *prima facie* case of obviousness of Applicant's invention simply cannot be made out with them.

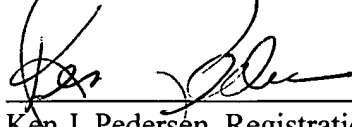
III. The Cited References Do Not Suggest Applicant's Amended Claims

Finally, nowhere in the two cited references are recited all the features of Applicant's newly amended claims. For example, neither Grogan nor Gutsch disclose a plurality of nested display containers, each with its own separate lid. Also, neither reference discloses separate lids which rest only on the top edges of the front, rear and side elements of the respective container. Therefore, even a combination of these two cited references does not make Applicant's invention obvious.

The other cited references in the Office Action, namely U.S. Patent #4,194,657 (Thor), U.S. Patent #4,325,597 (Morrison) and U.S. Patent # 6,264,527 (Sabol, Jr.), do not relate to the newly-claimed features of Claim 9, so they are not very relevant to Applicant's invention.

Applicant now believes the application is in condition for allowance and respectfully requests the same.

Respectfully submitted,

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Ken J. Pedersen, Registration No. 29,689

Barbara S. Pedersen, Registration No. 36,237

P.O. Box 2666

Boise, ID 83701-2666

Telephone: 208-343-6355

Facsimile: 208-343-6341